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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/555,630	07/06/2000	HIROSHI OKUBO	106348	1399

25944 7590 03/20/2003

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EXAMINER

ONEILL, MICHAEL W

ART UNIT PAPER NUMBER

3713

DATE MAILED: 03/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/555,630

Applicant(s)

OKUBO ET AL. *MA*

Examiner

Michael O'Neill

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-36 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

The restriction requirement of 12-31-02, Paper No. 6, is withdrawn.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1:

Group I, claim(s) 1-12 and 25-36, drawn to the game machine for using an optical disk using the synchronization means thereon and a method of reading an optical disk to utilize synchronization means thereon.

Group II, claim(s) 13-18, drawn to the information storage medium including synchronization data thereon.

Group III, claim(s) 19-21, drawn to the musical tone reproduction device.

Group IV, claim(s) 22-24, drawn to the information storage medium containing reproduction information for a tune and synchronization information for the tune's reproduction vis-à-vis image reproduction processing.

The inventions listed as Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the inventions within the groups having no special technical features as

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evidenced by the International Search Report which determined that all claims were either un-novel or lacked an inventive step because of the discovered relevant prior art the references listed on the form PCT 210 search report, see translation copy of the International Search Report.

Because the above groups of invention have no special technical features as evidenced by the International Search Report, the following inventions are considered related and are treated as follows:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-12 and 25-36, drawn to the subcombination of the game machine for using an optical disk using the synchronization means thereon and a method of reading an optical disk to utilize synchronization means thereon, classified in class 463, subclass 43.
- II. Claims 13-18, drawn to the subcombination of the information storage medium including synchronization data thereon, classified in class 463, subclass 31.
- III. Claims 19-21, drawn to the subcombination of the musical tone reproduction device, classified in class 84, subclass 600.

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IV. Claims 22-24, drawn to the subcombination of the information storage medium containing reproduction information for a tune and synchronization information for the tune's reproduction vis-à-vis image reproduction processing, classified in class 348, subclass 500.

Inventions Groups I, II, III and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the invention of Group I has separate utility such as being used a game machine with parallel video and audio data streams to perform synchronization of images and sound. The invention of Group II has separate utility as a separately distributed software product containing said synchronization data thereon. The invention of Group III has separate utility of a musical generator for audio-visual effects in multi-media presentations. The invention of Group IV has separate utility of video production for television programming. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by

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their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II, III, or IV, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Groups III or IV, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group III is not required for Groups I or IV, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group IV is not required for Groups I or II, restriction for examination purposes as indicated is proper.

Applicant's remarks filed 1-31-03 have been fully considered but are moot in view of the new restriction requirement. Also, it is noted that Applicants remarks are premised on the claimed inventions having special technical features. However, the evidence in the record, the

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International Search Report, demonstrates that none of the claimed inventions have special technical features; if they did, then the International Searching Authority would have not utilized X or Y designations for the references vis-à-vis the claims. Therefore, the Applicants remarks and citations to rules, procedures and case law are inconsequential to the issue within the instant application.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael O'Neill whose telephone number is 703-308-3484. The examiner can normally be reached on Monday through Thursday 9am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 703-308-1118. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3579 for regular communications and 703-305-3579 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

MON

March 18, 2003

A handwritten signature in black ink, appearing to read "M O'NEILL".

**MICHAEL O'NEILL
PRIMARY EXAMINER**